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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,183	07/09/2003	Robert G. Dickie	6121-33/DEH	9086

23477 7590 04/21/2004

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EXAMINER	
LEGESSE, NINI F	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/615,183	DICKIE, ROBERT G.	
	Examiner	Art Unit	
	Nini F. Legesse	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 July 0183*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 7-19* is/are rejected.

7)☒ Claim(s) *5 and 6* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/09/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: for example in page 5, line 2 the expression "which should appeared" need to be changed to - - which should appear - -, on page 11 line 4 the expression "the direction of light of a golf ball' need to be changed to - -the direction of flight of a golf ball", on line 11 line 14 the expression "the beams a laser light 44 and 46" need to be changed to - - the beams laser lights 44 and 46 - -. On page 9 line 12 the second end is identified as reference no. 14 and on line 22 this same second end is identified as reference no. 16. Appropriate correction is required.

Please note that the specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the microprocessor in claim 16 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 14 and 15 recite the expression "adapted to" on line 1. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

Claim Suggestions

In claim 6, line 2 the expression "the locus" need to be changed to - - the focus - - to correct typing error. In claim 10 line 2 the expression "elevated, zone" need to be changed to - -elevated zone - -.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Apthorp (US Patent No. 5,897,441).

With respect to claim 1, Apthorp discloses a golf swing practice device comprising:

- A body having first and second ends for securement to a golf club so that said first end is at the upper end of said golf club remote from said club head, and

said second end is fitted to the club shaft at a position below the grip portion thereof (see Fig. 1, first end is close to the very top of the golf club and the second end is close to where item 2 is located);

- Wherein said body has a pair of first laser light sources at said second end (3,4), said laser light sources emitting downwardly directed parallel beams of light (see Fig. 1).

Apthorp fails to teach that the first light sources create diverging beams of light. However, it would have been an obvious matter of choice for one of ordinary skill in the art to modify Apthorp's device to provide diverging light beams in the training device since parallel beams and diverging beams perform the same function and both work equally well.

With respect to claim 8, Apthorp fails to show wherein the distance between the light impingement targets being 15-21 cm, it appears that Apthorp device would be in that range too. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any distance including 15-21 cm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 9, Apthorp fails to show wherein the body of the device is to be formed from a polycarbonate plastics material. It would have been obvious to use

polycarbonate plastic because it is cheap and easy to manufacture. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any material including polycarbonate plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

Claims 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd (US Patent No. 5,590,882).

Todd discloses a practice mat comprising:

- A first elevated zone having the appearance and texture of grass or turf (T);
- A second zone in a plane below the elevation of the first zone and the second zone has a ball direction line (L. Note Fig. 1, which illustrates a ball direction line L parallel to edge 12 at the top of the Figure. See also col. 4, lines 28-43);
- Wherein the length of said second zone is greater than that of said first zone (see Figs. 1-2);
- Wherein the first zone is adapted to receive a golf tee (the turf T is capable of adapting a tee).

Todd discloses the invention as recited above but fails to show wherein the length of said second zone is greater that of said first zone. Todd's ball direction line L does not extend longitudinally because his mat is longer from front to back than from side to side.

However, it would have been an obvious matter of choice for one of ordinary skill in the art to make the mat larger so that it is longer from side to side than from front to back because doing so would provide the golfer with more space to practice and would provide additional space for ball direction line L so that it would be easier for the golfer to see and to swing his club in the proper direction. Providing this change in size would result in line L extending in the longitudinal direction.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 10 and further in view of Weygandt (US Patent No. 3,784,208). Todd fails to show fold lines. Weygandt teaches the use of fold lines (16). Even though Weygandt show just one fold line it would be obvious to have multiple fold lines for larger elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide fold lines as taught by Weygandt in the Todd device in order to make the device compact for storage.

Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 and further in view of Todd.

With respect to claim 11, Apthorp fails to include a mat as recited in the above claims. Todd discloses the mat as recited in the upper part of this office action. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the swing training golf device of Apthorp with a golf mat as taught by Todd in order to provide a multipurpose training device that could be used in different places.

With respect to claim 15, since the expression "adapted to" is not a positive limitation but only requires the ability to so perform, the first zone wherein the raised element (T) is located is considered to be capable of receiving a golf tee since it is disclosed as a turf in the Todd's reference.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 and further in view of Weygandt (US Patent No. 3,784,208). Apthorp fails to fold lines whereby the mat may be folded. Weygandt teaches the use of fold lines (16). Even though Weygandt show just one fold line it would be obvious to have multiple fold lines for larger elements. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide fold lines as taught by Weygandt in the Todd device in order to make the device compact for storage.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 10 and further in view of Ladick et al. (US Patent No. 4,858,934).

Todd fails to include the use of sensors, microprocessor, and an annunciator. Ladick teaches the use of sensors (86), microprocessor (100), and an annunciator (116). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide sensors, microprocessor, and an annunciator as taught by Ladick in the Todd element to provide the user with a visual display of the result of his golf swing.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 11 above, and further in view of Ladick et al. The references fail to include the use of sensors, microprocessor, and an annunciator. Ladick teaches the use of sensors (86), microprocessor (100), and an annunciator (116). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide sensors, microprocessor, and an annunciator as taught by Ladick in the references used above to provide the user with a visual display of the result of his golf swing.

Allowable Subject Matter

Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Garbe can be reached on (703) 308-1207. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NFL
04/15/04

Stephen P. Garbe
Primary Examiner